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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,935	07/13/2006	Stefaan Penne	PENN3001/JJC/PMB	9278
23364 7590 02/28/2011 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
GRABOWSKI, KYLE ROBERT				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
02/28/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,935

Applicant(s)

PENNE, STEFAAN

Examiner

Kyle Grabowski

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a second action Non-Final. Upon further consideration, the examiner agrees that Bergendahl does not fully anticipate the claimed subject matter of claims 10-12 and 15, as argued in the Remarks filed on 12/09/10.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4-6, and 9, are rejected under 35 U.S.C. 102(b) as being anticipated by Jewell (US 2,749,816).

4. In respect to claims 1 and 9, Jewell discloses a method comprising: providing a quire formed of folded sheets slipped into each other, e.g. two sheets of sheets slipped into one another (see Figure 4); providing a cut through the sheets of the quire as a short distance from the folded edge of the quire, such that every cut through the sheet of the quire forms a lip extending crosswise to the folding edge of the quire, the lip having a widening (center of the circle punch) (Fig. 3); and rolling up the quire along the folding edge of the quire via pushing the lips through under the bottom of the quire (Fig.

- 4). The examiner appreciates that the "rolling up" of the invention is previously executed before a cutting operation, however this is not explicitly claimed.
5. In respect to claims 4-6, Jewell further discloses that the cut is provided "slantingly" in relation to the quire by means of a profiled die which is partly pushed through the quire via a slanted die 27 not parallel to the quire (Fig. 3).
6. Claims 10-12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mission (US 2,587,749).
7. In respect to claim 10, Mission discloses a device comprising an inclined table 7 and a cutting mechanism 58; the device further includes a bowed portion (the relatively flat portion adjacent the inclined table 7) which begins at a position directly adjacent a recess 63 which has a shape corresponding to the contour of the cut to be formed (circular); a generally U-shaped stop 62 is placed within the bowed portion (Fig. 3). Although Mission does not disclose that the device is for binding a quire or that a lip is formed in the quire, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). (MPEP 2114). The structure is Mission is capable of forming a 'lip' either through incomplete punching (forming a "()" shape) or completely punching as disclosed, wherein a 'lip' can be construed to be any portion of the paper directly adjacent the punch (e.g. synonymous with "rim").
8. In respect to claims 11 and 12, Mission further discloses that the cutting means comprises a knife edge 61, wherein an edge of the knife closer to the U-shaped stop

(where the folding edge of the quire would be placed) is situated further away in the axial cutting direction from an opposing cutting edge (closer to the inclined table 7) (Fig. 3)).

9. In respect to claim 15, Mission further discloses clamping means 27 for aligning sheets to be cut, and equally capable of clamping a quire.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US 5,447,402).

13. In respect to claim 1, Kobayashi discloses a method comprising: providing sheets; providing a cut through the sheets a short distance from the an edge thereof,

such that every cut through the sheets forms a lip extending crosswise to the folding edge of the quire, the lip having a widening 6 (Fig. 6); and rolling up the sheets along an edge of the sheets via pushing the lips through under the bottom of the quire (Col. 1, 64-68). Kobayashi does not disclose the sheets comprise a quire formed of sheets folded into each other, however it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Kobayashi with a quire of sheets (sheets folded into each other) rather than a regular stack of sheets because providing a plurality of sheets as a quire is well known in the bookbinding art (<http://dictionary.reference.com/browse/quire>) and for the purposes of the binding operation taught in Kobayashi, whether the sheets are prefolded or not is irrelevant. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art, namely, providing the sheets in a pre-folded condition as is common in the collation of sheets before operations. One of ordinary skill would realize that performing the above binding operation on a quire of folded sheets would necessarily have to be preformed on the folded edge, as providing the binding on the other edge would preclude the sheets from opening.

14. In respect to claims 2-3 and 8, Kobayashi further disclose that the lips may be formed from several cuts into T-shapes and a widening of the lips 6 are situated at a distance from a far end of the lip turned toward the folding edge (Fig. 6).

Response to Arguments

15. Applicant's arguments, see Remarks, filed 12/09/10, with respect to the rejection(s) of claim(s) 10-12 and 15 under 102(b) and claims 1-6, 8, and 9, under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Jewell and Mission (102(b)) and Kobiyashi (103(a)).

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, 9am - 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725